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DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Part 1

[Docket No. PTO-P-2017-0011]

RIN 0651-AD21

Date of Receipt of Electronic Submissions of Patent Correspondence

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Notice of proposed rulemaking.

SUMMARY: The USPTO proposes to amend the patent rules of practice to provide that the receipt date of correspondence officially submitted electronically by way of the Office electronic filing system is the date in the Eastern time zone of the United States (Eastern Time) when the USPTO received the correspondence, rather than the date on which the correspondence is received at the correspondence address in Alexandria, Virginia. This is because the USPTO is expecting to provide physical servers for receiving electronic submissions in locations that are separate from the USPTO headquarters in Alexandria, Virginia. This proposed change will ensure consistency and predictability with respect to correspondence receipt dates as the date of receipt accorded to correspondence submitted electronically will not depend upon the location of USPTO servers. The USPTO is also proposing to amend the patent rules of practice to make other clarifying changes regarding the receipt of electronic submissions, including providing a definition for Eastern Time. These changes will harmonize the patent rules with the

trademark rules and provide clarity regarding the date of receipt of electronic submissions.

DATES: Comments must be received by **[INSERT DATE 60 DAYS AFTER DATE OF PUBLICATION IN THE FEDERAL REGISTER]** to ensure consideration.

ADDRESSES: For reasons of government efficiency, comments must be submitted through the Federal eRulemaking Portal at www.regulations.gov. To submit comments via the portal, one should enter docket number PTO-P-2017-0011 on the homepage and click “search.” The site will provide search results listing all documents associated with this docket. Commenters can find a reference to this notice and click on the “Comment Now!” icon, complete the required fields, and enter or attach their comments.

Attachments to electronic comments will be accepted in Adobe® portable document format or Microsoft Word® format. Because comments will be made available for public inspection, information that the submitter does not desire to make public, such as an address or phone number, should not be included in the comments.

Visit the Federal eRulemaking Portal for additional instructions on providing comments via the portal. If electronic submission of, or access to, comments is not feasible due to a lack of access to a computer and/or the internet, please contact the USPTO using the contact information below for special instructions.

FOR FURTHER INFORMATION CONTACT: For patent-related inquiries, please contact Mark O. Polutta, Senior Legal Advisor, Office of Patent Legal Administration, by telephone at 571-272-7709; or Kristie M. Kindred, Legal Advisor, Office of Patent Legal Administration, by telephone at 571-272-9016; or you can send inquiries by email to patentpractice@uspto.gov.

SUPPLEMENTARY INFORMATION: Under current 37 CFR 1.6(a)(4), the receipt date of correspondence submitted to the USPTO by way of the Office electronic filing system is “the date the correspondence is received at the correspondence address for the USPTO set forth in 37 CFR 1.1 when it was officially submitted.” Current 37 CFR 1.1 sets forth an Alexandria, Virginia, correspondence address for the Office. The USPTO’s physical servers that receive electronic submissions are currently located in Alexandria, Virginia. However, in order to enhance resiliency, the USPTO is in the process of providing servers in Manassas, Virginia, and in the future may provide servers outside of the Eastern time zone. Once the USPTO begins receiving electronically submitted patent correspondence at locations other than Alexandria, Virginia, the language in current 37 CFR 1.6(a)(4) that defines the date the correspondence is received at Alexandria, Virginia, as the receipt date would be inapplicable. Thus, the USPTO is proposing to revise 37 CFR 1.6(a)(4) to specify that the receipt date of correspondence that is officially submitted electronically by way of the Office electronic filing system is the date in Eastern Time when the USPTO received the correspondence, regardless of the physical location of the USPTO server that receives the correspondence. Other clarifying changes regarding the receipt date of electronic submissions, including providing a definition for Eastern Time, are also proposed.

In addition, the changes will align the patent rules with the Legal Framework for the Patent Electronic System, available at www.uspto.gov/patents/apply/filing-online/legal-framework-efs-web and in the Manual of Patent Examining Procedure (MPEP) section 502.05, subsection I. The Legal Framework already indicates that the time and date of receipt of an application filed via the Office electronic filing system is the local time and

date (Eastern Time) at the USPTO headquarters in Alexandria, Virginia, when the USPTO received the submission. The date of receipt is recorded after the user clicks the “SUBMIT” button on the “Confirm and Submit” screen. This is the date shown on the Electronic Acknowledgement Receipt. Similarly, follow-on documents filed in a patent application after the initial filing of the application are also accorded the date when the document is received at the USPTO as the date of receipt under existing practice. See MPEP section 502.05, subsection I.C.

With respect to patent correspondence, any references to the Office electronic filing system in this Notice (including in 37 CFR part 1) include EFS-Web and Patent Center. Patent Center is a new tool for the electronic filing and management of patent applications. Patent Center is currently in the Beta phase but is available for all users. Once fully developed, Patent Center will replace EFS-Web and the Patent Application Information Retrieval (PAIR) system. Users of Patent Center Beta are required to abide by the Legal Framework for the Patent Electronic System to the extent applicable and are expected to abide by the Patent Electronic System Subscriber Agreement. See the Patent Center Beta Release Guidelines available at www.uspto.gov/patents/apply/patent-center. In the future, as Patent Center gets closer to full development, the Legal Framework for the Patent Electronic System will be revised to expressly refer to and more specifically cover electronic submissions via Patent Center.

The rules of practice in trademark cases already provide that filing dates of electronic submissions are based on Eastern Time. See 37 CFR 2.195(a). Therefore, it is unnecessary to amend the trademark rules of practice.

Discussion of Specific Rules

The following is a discussion of the proposed amendments to 37 CFR part 1.

Section 1.1: Section 1.1(a) is amended to clarify the appropriate address information for patent-related correspondence. In particular, the clause “[e]xcept as provided in paragraphs (a)(3)(i) and (a)(3)(ii) of this section” is being changed to “[e]xcept for correspondence submitted via the Office electronic filing system in accordance with § 1.6(a)(4).” Further, the phrase “to specific areas within the Office as set out in paragraphs (a)(1) and (a)(3)(iii) of this section” is being replaced with “to specific areas within the Office as provided in this section.” Since the USPTO does not strictly require the provision of an address when patent-related correspondence is submitted via the Office electronic filing system, it is appropriate to exclude such correspondence from the address marking requirements of § 1.1(a). Applicants may continue to provide an address on correspondence submitted via the Office electronic filing system consistent with § 1.1(a), but it is not mandatory. The removal of references to specific sub-paragraphs (a)(3)(i) and (a)(3)(ii) from the introductory text of paragraph (a) is a technical correction in view of the remaining language in this section.

Section 1.6: Section 1.6(a)(4) is proposed to be amended to remove the reference to the physical location where correspondence must be received, and to provide that the receipt date of patent correspondence submitted using the Office electronic filing system is the date in Eastern Time when the correspondence is received in the USPTO. Specifically,

the USPTO proposes to change the phrase “Correspondence submitted to the Office by way of the Office electronic filing system will be accorded a receipt date, which is the date the correspondence is received at the correspondence address for the Office set forth in § 1.1 when it was officially submitted” to “Correspondence officially submitted to the Office by way of the Office electronic filing system will be accorded a receipt date, which is the date in Eastern Time when the correspondence is received in the Office.” In view of the relocation of the servers, it is appropriate to eliminate the reference to the correspondence address set forth in § 1.1 in connection with the receipt date of correspondence being filed electronically. Correspondence submitted via the Office electronic filing system will be accorded a receipt date based on the local time and date at the USPTO headquarters in Alexandria, Virginia, when the correspondence is received in the USPTO. Specifically, the Office electronic filing system will record the receipt date in Eastern Time after the user officially submits the correspondence by clicking the “SUBMIT” button on the “Confirm and Submit” screen and the correspondence is successfully received in the USPTO. Furthermore, the phrase “regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia” is being added to provide clarity in the rule. This is not a change in practice. See MPEP 502.05, subsection I.C.

It should be noted that the Legal Framework for the Patent Electronic System does not permit certain patent correspondence to be officially submitted via the Office electronic filing system. See MPEP 502.05, subsection I.B.2. Such correspondence will not be accorded a date of receipt or considered officially filed in the USPTO when submitted via

the Office electronic filing system. For example, notices of appeal to a court, district court complaints, or other complaints or lawsuits involving the USPTO may not be filed via the Office electronic filing system. See MPEP 1216 for instructions on how to properly serve and/or file documents seeking judicial review of a decision by the Patent Trial and Appeal Board.

Section 1.9: Section 1.9 is proposed to be amended to add a new paragraph (o) to set forth a definition for Eastern Time. In particular, Eastern Time is defined as meaning Eastern Standard Time or Eastern Daylight Time in the United States, as appropriate.

Rulemaking Considerations

A. Administrative Procedure Act: The changes proposed in this rulemaking involve rules of agency practice and procedure, and/or interpretive rules. See *Bachow Commc'ns Inc. v. FCC*, 237 F.3d 683, 690 (D.C. Cir. 2001) (rules governing an application process are procedural under the Administrative Procedure Act); *Inova Alexandria Hosp. v. Shalala*, 244 F.3d 342, 350 (4th Cir. 2001) (rules for handling appeals are procedural where they do not change the substantive standard for reviewing claims); *Nat'l Org. of Veterans' Advocates v. Sec'y of Veterans Affairs*, 260 F.3d 1365, 1375 (Fed. Cir. 2001) (rule that clarifies interpretation of a statute is interpretive).

Accordingly, prior notice and opportunity for public comment for the changes proposed in this rulemaking are not required pursuant to 5 U.S.C. 553(b) or (c), or any other law. See *Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1336-37 (Fed. Cir. 2008) (stating that 5

U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), do not require notice and comment rulemaking for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice” (quoting 5 U.S.C. 553(b)(A))). However, the USPTO has chosen to seek public comment before implementing the rule to benefit from the public’s input.

B. Regulatory Flexibility Act: Under the Regulatory Flexibility Act (5 U.S.C. 601 et seq.), whenever an agency is required by 5 U.S.C. 553 (or any other law) to publish a notice of proposed rulemaking, the agency must prepare and make available for public comment an Initial Regulatory Flexibility Analysis, unless the agency certifies under 5 U.S.C. 605(b) that the proposed rule, if implemented, will not have a significant economic impact on a substantial number of small entities. 5 U.S.C. 603, 605. For the reasons set forth herein, the Senior Counsel for Regulatory and Legislative Affairs, Office of General Law, of the USPTO has certified to the Chief Counsel for Advocacy of the Small Business Administration that the changes proposed in this rule will not have a significant economic impact on a substantial number of small entities (see 5 U.S.C. 605(b)).

This rulemaking amends the rules of practice to provide that the receipt date of correspondence officially submitted electronically by way of the Office electronic filing system is the date in Eastern Time when the Office received the correspondence. The USPTO is also proposing to amend the patent rules of practice to make other clarifying changes regarding the receipt of electronic submissions. These changes are procedural in

nature and would not result in a change in the burden imposed on any patent applicant, including a small entity.

For the reasons described above, the proposed changes will not have a significant economic impact on a substantial number of small entities.

C. Executive Order 12866 (Regulatory Planning and Review): This rulemaking has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

D. Executive Order 13563 (Improving Regulation and Regulatory Review): The USPTO has complied with Executive Order 13563 (Jan. 18, 2011). Specifically, the USPTO has, to the extent feasible and applicable: (1) Made a reasoned determination that the benefits justify the costs of the rule; (2) tailored the rule to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives; (6) involved the public in an open exchange of information and perspectives among experts in relevant disciplines, affected stakeholders in the private sector, and the public as a whole, and provided online access to the rulemaking docket; (7) attempted to promote coordination, simplification, and harmonization across government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes.

E. Executive Order 13132 (Federalism): This rulemaking does not contain policies with federalism implications sufficient to warrant the preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

F. Executive Order 13175 (Tribal Consultation): This rulemaking will not: (1) Have substantial direct effects on one or more Indian tribes; (2) impose substantial direct compliance costs on Indian tribal governments; or (3) preempt tribal law. Therefore, a tribal summary impact statement is not required under Executive Order 13175 (Nov. 6, 2000).

G. Executive Order 13211 (Energy Effects): This rulemaking is not a significant energy action under Executive Order 13211 because this rulemaking is not likely to have a significant adverse effect on the supply, distribution, or use of energy. Therefore, a Statement of Energy Effects is not required under Executive Order 13211 (May 18, 2001).

H. Executive Order 12988 (Civil Justice Reform): This rulemaking meets applicable standards to minimize litigation, eliminate ambiguity, and reduce burden as set forth in sections 3(a) and 3(b)(2) of Executive Order 12988 (Feb. 5, 1996).

I. Executive Order 13045 (Protection of Children): This rulemaking does not concern an environmental risk to health or safety that may disproportionately affect children under Executive Order 13045 (Apr. 21, 1997).

J. Executive Order 12630 (Taking of Private Property): This rulemaking will not affect a taking of private property or otherwise have taking implications under Executive Order 12630 (Mar. 15, 1988).

K. Congressional Review Act: Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 et seq.), prior to issuing any final rule, the USPTO will submit a report containing the final rule and other required information to the United States Senate, the United States House of Representatives, and the Comptroller General of the Government Accountability Office. The changes in this rulemaking are not expected to result in an annual effect on the economy of \$100 million or more; a major increase in costs or prices; or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of United States-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this rulemaking is not expected to result in a “major rule” as defined in 5 U.S.C. 804(2).

L. Unfunded Mandates Reform Act of 1995: The changes set forth in this rulemaking do not involve a Federal intergovernmental mandate that will result in the expenditure by State, local, and tribal governments, in the aggregate, of \$100 million (as adjusted) or more in any one year, or a Federal private sector mandate that will result in the expenditure by the private sector of \$100 million (as adjusted) or more in any one year, and will not significantly or uniquely affect small governments. Therefore, no actions are necessary under the provisions of the Unfunded Mandates Reform Act of 1995. See 2 U.S.C. 1501 et seq.

M. National Environmental Policy Act of 1969: This rulemaking will not have any effect on the quality of the environment and is thus categorically excluded from review under the National Environmental Policy Act of 1969. See 42 U.S.C. 4321 et seq.

N. National Technology Transfer and Advancement Act of 1995: The requirements of section 12(d) of the National Technology Transfer and Advancement Act of 1995 (15 U.S.C. 272 note) are not applicable because this rulemaking does not contain provisions that involve the use of technical standards.

O. Paperwork Reduction Act of 1995: The Paperwork Reduction Act of 1995 requires that the USPTO consider the impact of paperwork and other information collection burdens imposed on the public. This rulemaking does not involve any new information collection requirements that are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 et seq.).

Notwithstanding any other provision of law, no person is required to respond to, nor shall a person be subject to a penalty for failure to comply with, a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information has a currently valid OMB control number.

List of Subjects

37 CFR Part 1

Administrative practice and procedure, Biologics, Courts, Freedom of information, Inventions and patents, Reporting and recordkeeping requirements, Small businesses.

For the reasons set forth in the preamble, 37 CFR part 1 is amended as follows:

PART 1 – RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR part 1 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2).

2. Section 1.1 is amended by revising the paragraph (a) introductory text to read as follows:

§ 1.1 Addresses for non-trademark correspondence with the United States Patent and Trademark Office.

(a) *In general.* Except for correspondence submitted via the Office electronic filing system in accordance with § 1.6(a)(4), all correspondence intended for the United States Patent and Trademark Office must be addressed to either “Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450” or to specific areas within the Office as provided in this section. When appropriate, correspondence should also be marked for the attention of a particular office or individual.

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3. Section 1.6 is amended by revising paragraph (a)(4) to read as follows:

§ 1.6 Receipt of Correspondence.

(a) * * *

(4) Correspondence may be submitted using the Office electronic filing system only in accordance with the Office electronic filing system requirements. Correspondence officially submitted to the Office by way of the Office electronic filing system will be accorded a receipt date, which is the date in Eastern Time when the correspondence is received in the Office, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia.

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Section 1.9 is amended by adding a new paragraph (o) to read as follows:

§ 1.9 Definitions.

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(o) Eastern Time as used in this chapter means Eastern Standard Time or Eastern Daylight Time in the United States, as appropriate.

Andrew Hirshfeld,

Commissioner for Patents, Performing the Functions and Duties of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

